



PATENT
Customer No. 22,852
Attorney Docket No. 06502.0336-00000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
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Nang Kon KWAN) Group Art Unit: 2131
)
Application No.: 09/931,004) Examiner: L. Chai
)
Filed: August 17, 2001) Confirmation No. 2756
)
For: CLIENT CONTROLLED DATA)
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Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicant requests a pre-appeal brief review of the Final Office Action dated August 4, 2005. This Request is being filed concurrently with a Notice of Appeal.

I. Requirements For Submitting a Pre-Appeal Brief Request for Review

Applicant may request a pre-appeal brief review of rejections set forth in an Office Action if (1) the application has been at least twice rejected; (2) Applicant concurrently files the Request with a Notice of Appeal prior to filing an Appeal Brief; and (3) Applicant submits a Pre-Appeal Brief Request for Review that is five (5) or less pages in length and sets forth legal or factual deficiencies in the rejections. See Official Gazette Notice, July 12, 2005.

Applicant has met each of these requirements and therefore request review of the Examiner's rejections in the Final Office Action for the following reasons.

II. The Examiner Did Not Establish a *Prima Facie* Case of Obviousness in Rejecting Claims 1-10, 12-21, 25-28, and 30-33 Under 35 U.S.C. § 103(a)

To establish a *prima facie* case of obviousness, the Examiner must show, among other things, the prior art reference or references, taken alone or combined, must teach or suggest each and every element recited in the claims. (See M.P.E.P. § 2143.03.) The Examiner has not met this burden in rejecting claims 1-10, 12-21, 25-28, and 30-33 under 35 U.S.C. § 103(a) because, *inter alia*, the cited art does not support the Examiner's assertions and the Examiner does not address all of the recitations of Applicant's claims.

The Examiner admits *Bisbee et al.* does not teach "providing an indication of proof of storing the encrypted user's encryption key, wherein the indication of proof is signed with a second archival key." (Final OA at 3.) To satisfy this deficiency, the Examiner asserts *CFSB* teaches this feature, citing to portions of the first and fourth paragraphs of *CFSB*. (Final OA at 3.) As explained in the Amendment filed June 17, 2005, neither *CFSB* or *Bisbee et al.* support the Examiner's position for establishing a *prima facie* case of obviousness. The mere fact that *CFSB* describes key certificates signed by a key holder does not provide a showing that the cited art, alone or in combination, teaches or suggests the recitations of the claims. For instance, the Examiner's interpretation that "the key escrow certificate is served as the indication of proof that the key has been escrowed when provided to CA as taught by *CFSB*," does not address the claimed recitations that the request is provided to the certificate authority based on the verification of the signed indication of proof, as recited in claims 1, 15, and 33. (Final OA at 3.) That is, according to *CFSB*, the certificate authority (i.e., "CA") receives proof that a key has been escrowed, and does not address receiving a request from a user for a digital certificate based on the verification of the signed indication of proof, as recited in claims 1, 15, and 33.

Further, the Examiner improperly misconstrues the cited art to support the asserted rejections of Applicant's claims. For Example, the Examiner asserts the "Registration Manager (RM)" (i.e., RA as noted in *Bisbee et al.*) corresponds to a requesting entity. Based on this premise, the Examiner alleges the "RM" must receive an indication of proof that it can "verify the indication of proof is indeed performed and

sent by the authorized key escrow agent certified as meeting the standards.” (Final OA at 4.) To support this assertion, the Examiner refers to a portion of *CFSB*, which merely describes the choice of users in selecting a certified key holder. (See Final OA at 4 and *CFSB*, ¶ 4, lines 1-2.) This portion of *CFSB*, nor any other portion, does not support the Examiner’s conclusion that a “requestor” (i.e., a request for a digital certificate) “must” receive a verification that a key has been escrowed. Indeed, *CFSB* specifically teaches away from such an assertion in stating that the “CA would need proof that the key has been escrowed.” (*CFSB* at ¶ 1, lines 5-6.) Moreover, the cited art, most notably *CFSB*, would not suggest sending the request to a certificate authority based on the verification of a signed indication of proof because, as noted above, the certificate authority is the entity that receives the “proof” of an escrowed key. Accordingly, the Examiner improperly applies the cited art to reject claims 1, 15, and 33 (and their respective dependent claims) under 35 U.S.C. § 103(a), and as such, the cited art does not support a *prima facie* case of obviousness, as asserted by the Examiner.

Moreover, the Examiner improperly ignores recitations of certain claims in asserting the cited art teaches or suggests Applicant’s claims. As such, the Examiner has not met the requirements of M.P.E.P. § 2143 to establish a *prima facie* case of obviousness. For example, the Examiner merely rejects claims 10, 12, 16, 17, 18, 28, and 30 for the “same reasons set forth for claim 1.” (Final OA at 7.) These claims, however, recite features that are not claimed in claim 1, and thus require consideration and a showing by the Examiner that the cited art renders the features obvious. The Examiner has not done so in the Final Office Action. For example, as noted by Applicant in the June 17 Amendment, claims 10, 12, 17, and 28, each requires, *inter alia*, sending a request for a digital certificate based on the verifying of a digital signed indication of proof. (Amendment, 6/17/05 at 16.) Claim 16 requires a processor configured to send a request for a digital certificate, the request having a verified indication of proof of archival or an encryption key for the user in an entity separate from the certificate authority.” Claim 18 recites, *inter alia*, a registration manager configured to receive a digital certificate request and receive an indication of proof of archival in response to sending a user’s encryption key, a data recovery manager configured to create and send an indication of proof of archival, a certificate authority configured to

issue a digital certificate when it is determined that an indication of proof or archival is received. Also, claim 30 requires, *inter alia*, providing an indication of proof to a second entity that provides a request for a digital certificate from a certificate authority based on a verification of the indication of proof. Contrary to the requirements of M.P.E.P. § 2143, none of these features are addressed by the Examiner. Nor does the Examiner address the arguments by Applicant describing the deficiencies in the cited art. (See e.g., Amendment, 6/17/05, at 16-19.) Also, contrary to the requirements for showing a *prima facie* case of obviousness, none of the cited art teaches or suggests these features. As such, the positions set forth in the Final Office Action do not meet the requirements for establishing a *prima facie* case of obviousness, and thus Applicant respectfully requests reconsideration of the rejection of claims 1-10, 12-21, 25-28, and 30-33 under 35 U.S.C. § 103(a) and that the recitations of each of these claims be properly addressed in any future rejection(s) set forth by the Examiner.

Further, the Examiner's reason for combining the reference is conjecture and does not support the combination asserted by the Examiner. As noted previously, the Examiner cited *CFSB* to allegedly make up for the lack of teachings of *Brisbee et al.*, namely "providing an indication of proof of storing the encrypted user's encryption key." (OA at 4.) In an attempt to show motivation for the suggested combination, however, the Examiner refers to *Bisbee et al.*'s registration manager "RM" and *CFSB*'s descriptions regarding the ability of users to select trusted escrow agents, neither of which show a reason to combine the cited art for the alleged combination of using an indication of proof within *Brisbee et al.*

Further, the Examiner does not address the deficiencies noted by Applicant regarding the alleged combination of the cited art to suggest Applicant's claims. For instance, as noted in the June 17 Amendment, the mere fact that *CFSB* mentions a key escrow system does not show that a skilled artisan would have been motivated to provide indications of proof in a manner recited in Applicant's claims. Instead, under the Examiner's asserted reasoning, the alleged combination would, at most, result in *Brisbee et al.* selecting trusted entities as the directory certificate repository (DCR), which may store certificates (*Brisbee et al.* 11:37-41.) This resulting combination, however, does not meet the recitations of Applicant's claims.

III. Conclusion

In light of the above arguments and those presented in the Request, Applicant submits that the Examiner failed to establish a *prima facie* case of obviousness in rejecting claims 1-10, 12-21, 25-28, and 30-33. Therefore, the rejection of these claims under 35 U.S.C. § 103(a) should be withdrawn and the claims allowed.

Respectfully submitted,

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Dated: September 15, 2005

By: _____

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